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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,554	07/02/2001	Alan R. Tall	64077/JPW/ADM	2853

7590

03/10/2003

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EXAMINER

LI, RUIXIANG

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 03/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/898,554

Applicant(s)

TALL ET AL.

Examiner

Ruixiang Li

Art Unit

1646

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,9,39-46 and 51-60 is/are pending in the application.
- 4a) Of the above claim(s) 9,39 and 42-46 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 41 and 51-58 is/are allowed.
- 6) ☒ Claim(s) 5,40,59 and 60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

I. Status of Application, Amendments, and/or Claims

The amendment filed in Paper No. 10 on December 12, 2002 has been entered in full. Claims 1, 2, 10-12, 37, 38, 47-50 have been canceled. Claims 5 and 41 have been amended. Claims 51-60 have been added. Claims 5, 9, 39-46, and 51-60 are pending. Claims 5, 40, 41, and 51-60 are under consideration. All other claims, including claim 39 which recites unelected subject matter (SEQ ID NO: 39) and was overlooked by the Examiner in the previous Office action (Paper No. 9, September 6, 2002), are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

II. Withdrawn Objections and/or Rejections

The rejection of claims 12, 47, and 48 under 35 USC § 112, 1st paragraph, as set forth at pages 3 –4 of the previous Office Action (Paper No. 9, September 6, 2002) has been withdrawn in view of applicants' cancellation of claims 12, 47, and 48.

The objection of claims 1, 2, 10-12, 37, 38, and 47-50 for minor informalities, as set forth at page 5 of the previous Office Action (Paper No. 9, September 6, 2002) has been withdrawn in view of applicants' cancellation of the claims.

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The objection of claims 5 and 40 for minor informalities, as set forth at page 5 of the previous Office Action (Paper No. 9, September 6, 2002) has been withdrawn in view of applicants' amendment to claim 5.

The objection of claim 41 for minor informalities, as set forth at page 5 of the previous Office Action (Paper No. 9, September 6, 2002) has been withdrawn in view of applicants' amendment to claim 41.

III. Claim Rejections Under 35 U. S. C. § 112, 2nd Paragraph

Claims 5 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the term "specifically hybridizes", without giving the hybridization conditions in the claim. Since neither the specification/claim nor the art provides a definition for the term and the hybridization conditions, the claim is indefinite. Claim 40 depends from claim 5.

IV. Claim Rejections Under 35 U. S. C. § 102

(i) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(ii) Claims 5 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagase et al. (*IDS, Biochem. J.* 330:1417-1422, 1998).

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Nagase et al. teach a cDNA encoding a rat LOX-1 protein of 364 amino acids. Nagase et al. further teach preparation of probes for rat LOX-1, which were labelled with [α -³²P]dCTP (see, e.g., Abstract; Fig. 1; page 1419, in particular 2nd and 3rd paragraphs of left column). Thus, the reference of Nagase et al. meets the limitations of claims 5 and 40.

(iii) Claims 59 and 60 are rejected under 35 U.S.C. 102(b) as being anticipated by Sawamura et al. (*IDS, Nature* 386:73-77, 1997).

Sawamura et al. teach a total cell lysate and a soluble extract comprising Lox-1 (See, e.g., bottom of page 73; Figure 1; top of right column of page 77). It is noted that claims 59 and 60 are drawn to a product by a process. Since a new process of obtaining a product, where the product is already known in the art, does not distinguish the product from the art. Thus, the reference of Sawamura et al. meets the limitations of claims 59 and 60.

V. Conclusion

Claims 41 and 51-58 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruixiang Li whose telephone number is (703) 306-0282. The examiner can normally be reached on Monday-Friday, 8:30 am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564. The fax phone number for this Group is (703) 305-3014 or (703) 308-4242.


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Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [yvonne.eyler@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Ruixiang Li
Examiner
February 2, 2003


YVONNE EYLER, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600